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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,718	04/14/2004	Chad M. Orthaus	71-851-1	5236

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EXAMINER

HARTMANN, GARY S

ART UNIT	PAPER NUMBER
3671	

DATE MAILED: 08/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/823,718	ORTHAUS ET AL.	
	Examiner	Art Unit	
	Gary Hartmann	3671	MLW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-27 and 37-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20,21,23-27,37,39-41,43,45-51,53 and 55-58 is/are rejected.
- 7) ☒ Claim(s) 22,38,42,44,52 and 54 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/14/4</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The abstract of the disclosure is objected to because it is not specifically directed to the apparatus of the claimed invention. Correction is required. See MPEP § 608.01(b).

Claim Objections

Claim 57 is objected to because of the following informalities: "ap-pling" should be -- applying--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 37, 39 and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by Eigenmann (U.S. Patent 4,792,259). Eigenmann discloses an apparatus for serially dispensing raised pavement markers (A) having upper and lower surface portions. There are adhesive means (see second paragraph of abstract, for example) adapted to be fixedly mounted upon bottom surface portion of the markers. The markers and adhesive means are separably adhered to a single release sheet (B). There are means for causing a leading one of the pavement markers to be separated (see Figure) and the bottom portion of the marker is deposited directly onto a pavement surface (S).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20, 21, 23-27, 40, 41, 43, 45-48, 50, 51, 53 and 55-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eigenmann, as applied above.

It is unclear whether the markers of Eigenmann are disposed in a nested array; however, it appears from the figure that in the rolled up, stored configuration, the markers would be disposed atop one another in a nested array. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used this configuration with Eigenmann in order to minimize storage space, in accordance with the invention of Eigenmann.

Eigenmann is silent regarding the relative widths of the marker and sheet. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have prevented the markers from becoming laterally unstable while on the sheet.

Eigenmann does not teach the stripper plate; however, since the markers are secured to the release sheet, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a stripper plate in order to ease separation of the markers from the sheet.

Eigenmann is deemed to meet the recitations regarding the indexably moving an indexable roller.

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A drive motor is inherently connected to the roller of Eigenmann, in order to operate the apparatus. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a program logic controller therewith in order to apply the markers in the desired spatial relationship with one another along the roadway.

It is common practice to use an applicator wheel in order to rollingly engage markers; thereby improving attachment with the pavement surface. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used an applicator wheel with Eigenmann for this purpose.

Allowable Subject Matter

Claims 22, 38, 42, 44, 52 and 54 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Hartmann whose telephone number is 703-305-4549. The examiner can normally be reached on Monday through Friday, 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Will can be reached on 703-308-3870. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3671

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gary Hartmann
Primary Examiner
Art Unit 3671

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